

REMARKS

Claims 1-33 are pending, of which claims 1, 10, and 16 are independent method claims and claim 25 is an independent computer program product claim corresponding to claim 1. As indicated above, claims 1, 10, 16, and 25 have been amended by this paper.

The Office Action rejected each of the pending independent claims (1, 10, 16, and 25) under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,636,733 to Helferich ("*Helferich*"). The Office Action rejected the dependent claims as either anticipated under 35 U.S.C. § 102(e) by *Helferich* or as unpatentable under 35 U.S.C. § 103(a) over *Helferich* in view of U.S. Patent No. 6,421,707 to Miller et al. ("*Miller*").¹

Applicants' invention, as claimed for example in independent method claim 1, relates to composing an electronic message using a mobile device. The method includes receiving a command to begin composing an electronic message at a mobile device, receiving a command to add audio content to the electronic message at the mobile device, diverting to a temporary storage within the mobile device, an audio content stream received at an audio input, storing the audio content stream within the mobile device in a format that is compatible with adding audio content to the electronic message, and attaching the formatted audio content to the electronic message at the mobile device.

Helferich discloses a messaging system that includes an email server, a message processor, and a mobile system that are external to a mobile phone. Figure 1. *Helferich's* messaging system allows a mobile phone user to reply to an email message with a voice message. Col. 3, l. 66 – col. 4, l. 2; Figure 1. When the email server receives an email message for the mobile phone user, the server stores the message and assigns a message ID, such as a telephone callback number. Col. 4, ll. 2-10. Once the mobile telephone receives the email message, the user may reply to the email by activating a reply command. Col. 4, ll. 32-37. In response to the reply command, the mobile phone automatically places a call to the callback number assigned to the message. Col. 4, ll. 37-43. Upon receiving a call directed to a specific callback number, the message processor prompts the mobile phone user to dictate a reply message, records the voice reply, notifies the email server of the voice reply, and provides the

¹Although the prior art status of *Helferich* and *Miller* is not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of *Helferich* and *Miller*.

server with the callback telephone number. Col. 4, ll. 57-67. The email server uses the callback telephone number to retrieve the corresponding email message, and then transmits the voice message to the originator of the corresponding message. Col. 5, ll. 1-6. In a similar fashion, the mobile phone user may originate voice email messages. Col. 6, ll. 50-63.

Miller discloses a wireless multimedia messaging communications method and apparatus. Col. 1, ll. 39-44. As disclosed in *Miller*, a subscriber device includes an email client module that provides standard email functionality, such as browsing, sending, reply-to, and selective retrieval of email messages or their components. Col. 3, ll. 48-51; Figure 2. A user can elect to have part of an email message "read" by the system, have an audio attachment played for listening, or have a voice notification for a message delivered to a specified phone number. Col. 5, ll. 64-65; col. 6, ll. 20-24 & 29-38.

"[F]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP § 706.02. As indicated above, *Helperich* discloses a message processor external to a mobile device that records a voice reply, and an email server external to the mobile device that sends the voice reply to the message originator. In contrast to *Helperich*, Applicants' invention, as claimed for example in independent claims 1, 10, 16, and 25, relates to composing an electronic message using a mobile device or wireless telephone. To further clarify that the method is carried out by a mobile device or wireless telephone, each of the limitations has been amended to explicitly recite that the corresponding operations occur at or within the mobile device or wireless telephone.² Accordingly, because *Helperich* teaches an external message processor and email server, *Helperich* fails to teach every aspect of the claimed invention, as claimed in independent claims 1, 10, 16, and 25, and therefore the rejection of these claims under 35 U.S.C. § 102(e) as being anticipated by *Helperich* should be withdrawn. Furthermore, even if the Office Action had asserted that the claimed invention was obvious in view of *Helperich*, Applicants respectfully submit that *Helperich* teaches away from or is contrary to Applicants' claimed invention since *Helperich* teaches voice processing that is external to a mobile device and offers no teaching or suggestion that the voice processing occur elsewhere.

²Applicants respectfully submit for the record that while these amendments emphasize one distinction between *Helperich* and Applicants' invention, the amendments do not necessarily narrow the scope of the claims since each of the independent claims as originally filed was directed to composing an electronic message using a mobile device.

See MPEP 2145(X)(D)(1) ("A prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness.").

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. With respect to dependent claims 5, 14, 21, and 29, the Office Action acknowledges that *Helferich* fails to disclose the respective claim limitations, but asserts that in Figure 4(m) *Miller* discloses displaying the size of a received email "Entire Mail (73K)" in comparison to a predetermined maximum size of a user's mailbox "700KB" as shown in Figure 4(c). Office Action, p. 9 (rejection of claims 5, 14, 21, and 29). Applicants respectfully disagree.

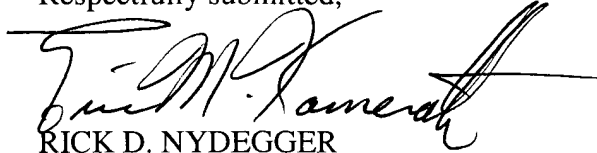
First, Applicants do not claim displaying the size of a received email. Rather, claims 5, 14, 21, and 29 recite displaying a progress indicator to show a current amount of temporary storage used in storing a received audio content data stream compared to a predetermined maximum for an electronic message. Second, while *Miller's* Figure 4(m) shows the display of a cellular telephone handset, Figure 4(c) clearly does not. Arguably, it would not even be possible to display the computer screen of Figure 4(c) on a cellular telephone handset. Third, even assuming for the sake of argument that the size of an email is the same as the current amount of temporary storage used in storing a received audio content stream, and that the maximum size of the user's inbox is the same as a predetermined maximum amount of audio content that may be stored in the temporary storage for the electronic message, how can the computer screen shown in Figure 4(c) and the separate cellular telephone handset shown in Figure 4(m) represent displaying a progress indicator when *Miller* does not teach, suggest, or motivate displaying both figures or information from the figures at the same time?

Based on at least the foregoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or make obvious Applicants invention, as claimed for example, in independent claims 1, 10, 16, and 25. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertion with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 13th day of April 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", written over the printed name.

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